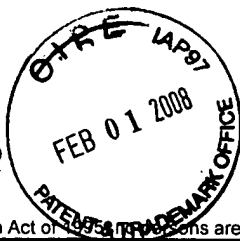


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05793.3054

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name _____

Application Number

10/032,469

Filed

January 2, 2002

First Named Inventor

Jennifer BRYMAN et al.

Art Unit

3622

Examiner

Donald Champagne

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number 46,508☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Joseph E. Palys

Typed or printed name

571-203-2713

Telephone number

February 1, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Attorney Docket No. 05793.3054-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Jennifer BRYMAN et al.)	Group Art Unit: 3622
)	
Application No.: 10/032,469)	Examiner: Donald Champagne
)	
Filed: January 2, 2002)	
)	
For: SYSTEMS AND METHODS FOR ISSUING)	Confirmation No.: 5583
PARTNERSHIP CHECKS TO A CUSTOMER)	
HAVING A FINANCIAL ACCOUNT)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections set forth in the Final Office Action mailed on November 1, 2007 (hereinafter, "OA"). Applicants respectfully assert that (1) the application has been at least twice rejected; (2) this request is being filed concurrently with a Notice of Appeal; (3) this request is being filed prior to an Appeal Brief; and (4) this request is five or less pages in length, all in accordance with the guidelines set forth in the Official Gazette Notice of July 12, 2005. Applicants request the prompt review of the Examiner's rejections set forth in the Final Office Action.

In the Office Action mailed November 1, 2007, the Examiner rejected claims 1-9, 12-16, and 18-26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,483,049 to Schulze, Jr. (hereinafter, "*Schulze*"); and rejected claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Schulze*. For the reasons stated below, Applicants respectfully submit that the final rejection is legally deficient, and should be withdrawn.

I. The Rejection of Claim 18 Under 35 U.S.C. § 102(b) is Legally Deficient Because the Examiner's Application of the Theory of Inherency is Improper

The Examiner admits that *Schulze* fails to teach “generating a list of prospective merchants,” and instead alleges that “‘generating a list of prospective merchants’ is inherent.” OA, p. 3. “In relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *M.P.E.P.* § 2112(IV) (internal citations omitted) (emphasis in original). “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.*

In the present case, however, the Office Action has not provided any rationale or reasoning to support the position that “generating a list of prospective merchants” is inherent. Indeed, *Schulze* does not generate a list of prospective merchants, and thus cannot support the rejection of claim 18.

Accordingly, *Schulze* does not support the rejection of independent claim 18 under 35 U.S.C. § 102(b), and the theory of inherency is insufficient to close the gap. Therefore, the rejection of independent claim 18, and its corresponding dependent claims 19-21, under 35 U.S.C. § 102(b) is legally deficient, and should be withdrawn.

II. The Rejection of Independent Claims 13 and 18 Under 35 U.S.C. § 102(b) is Legally Deficient Because the Prior Art Fails to Show the Recited Elements of Each of the Independent Claims and the Examiner Has Failed to Make a *Prima Facie* Case of Anticipation

The Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. § 102 in that the Examiner has failed to address all of the recitations of each of independent claims 13 and 18. A proper anticipation rejection requires each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* § 2131 (emphasis added). 37 C.F.R. § 1.104(c) requires that the Office Action provide more than an unsupported assertion that a reference discloses the subject matter recited in a rejected claim. In particular, “[w]hen a reference [i.e., *Schulze*] is complex or shows or describes inventions other than that claimed by Applicant, the particular part relied on must be designated as nearly as practicable,” and further, “[t]he pertinence of each reference, if not apparent, must

be clearly explained and each rejected claim specified.” 37 C.F.R. § 1.104(c)(2). In this case, the Examiner applies *Schulze* to only a portion of one recitation of independent claim 13, and applies *Schulze* to only two of five recitations of independent claim 18.

For example, in claim 13, the Examiner asserts that *Schulze* teaches “forming a ‘value sharing relationship’ with at least one retailer (merchant)” However, this claim 13 recitation actually requires “forming a value sharing relationship between the issuer and at least one merchant” (emphasis added). Moreover, the Examiner does not attempt to apply *Schulze* to other claim 13 recitations, including “generating partnership checks that are redeemable with the at least one merchant, each of the partnership checks including printed indicia that is indicative of a predetermined transaction amount” and “providing an incentive with each partnership check, wherein the incentive extends to customers that use the partnership check.” Selectively applying *Schulze* to only a portion of this one recitation, and neglecting to apply *Schulze* to the remaining recitations of independent claim 13 is improper.

In claim 18, the Examiner incorrectly asserts that “‘generating a list of prospective merchants’ is inherent.” OA, p. 3. As explained above, the Examiner has misapplied the theory of inherency. In addition, the Examiner fails to address the recitations of claim 18, including “analyzing the list of prospective merchants based on a set of merchant qualification criteria to form a set of merchants,” “analyzing the list of prospective customers based on a set of customer qualification criteria to form a set of customers,” and “issuing partnership checks to the set of customers, wherein each of the partnership checks includes an incentive that extends to customers that use the partnership check as part of a financial transaction with the set of merchants.” Indeed, the Examiner maintains the same rejections and remarks in both the Non-Final Rejection, mailed 1/08/07, and the Final Rejection, mailed November 1, 2007. Thus, the Examiner has failed to apply the cited art and clearly develop the issue, as required by the *M.P.E.P.* and 37 C.F.R. § 1.104.

Therefore, the rejection of independent claims 13 and 18, and their respective dependent claims 14-17 and 19-21, under 35 U.S.C. § 102(b) is legally deficient, and should be withdrawn.

III. The Rejection Under 35 U.S.C. § 103(a) is Legally Deficient Because the Examiner's Taking of Official Notice is Improper

In both the Non-Final and Final Office Actions, the Examiner rejected claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Schulze*. Both times, to support this position, the Examiner took Official Notice. *See* OA, pp. 3-4. According to the Examiner, “inserts (claims 10 and 17) with the mailed coupon/check and an incentive chosen so as to maximize profit (claim 11) . . . were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention.” OA, p. 3. However, the Office Action failed to address the other claim recitations, and further failed to provide any reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of *Schulze*. Applicants traversed the taking of Official Notice in the Response to Office Action, filed April 9, 2007.

A general allegation that something may be “well known” is not sufficient to support a taking of Official Notice. “[T]he basis for [the examiner’s] reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” *M.P.E.P.* § 2144.03(B) (internal citations omitted) (emphasis added). “The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” *Id.* That is, it is the Examiner’s burden to present the explicit basis for taking Official Notice. In the Final Office Action, however, the Examiner stated that “applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice . . . [and] [t]he examiner’s taking of official notice is maintained.” OA, p. 3.

However, Applicants can only rebut the taking of Official Notice to the extent that the Examiner has provided “sound technical and scientific reasoning to support his or her conclusion of common knowledge.” *M.P.E.P.* § 2144.03(B) (internal citations omitted). To reject three claims, the Examiner merely states that “inserts (claims 10 and 17) with the mailed coupon/check and an incentive chosen so as to maximize profit (claim 11) . . . were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention.”

OA, p. 3. In other words, the Examiner provided no reasoning, only stating that these items were in common use and obvious. This is improper.

Moreover, to establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Office Action must show, *inter alia*, that the applied reference teaches each and every element recited in the claims. *M.P.E.P.* § 2143. Here, by ignoring the recitations of claims 10, 11, and 17, the Office Action has failed to show how the cited art purportedly discloses the recitations of these claims. Specifically, the Office Action has failed to show how *Schulze* discloses "sending informative inserts to the set of customers with the partnership check," as recited in dependent claim 10. In addition, the Office Action has failed to show how *Schulze* discloses "providing an economic incentive with the partnership check for customers that use the partnership check, wherein the type of economic incentive is determined based on maximizing profit for an issuer of the partnership check and the merchant," as recited in dependent claim 11. Moreover, the Office Action has failed to show how *Schulze* discloses "sending partnership checks to customer with information material," as recited in dependent claim 17.

Thus, the rejection of dependent claims 10, 11, and 17 does not meet the requirements of at least *M.P.E.P.* § 2143 and 35 U.S.C. § 103(a), and is therefore legally improper.

IV. Conclusion

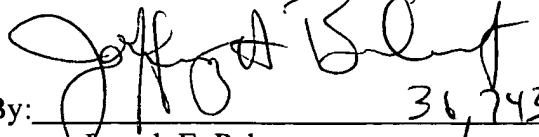
For the foregoing reasons, Applicants respectfully submit that the rejection of claims 1-26 includes legal deficiencies entitling Applicant to a pre-appeal brief review of the Final Office Action. Applicants request that the rejection be withdrawn and the claims allowed. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 1, 2008

By: _____


Joseph E. Palys
Reg. No. 46,508

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